

## **STATUS OF CLAIMS**

Claims 1 - 20 are pending.

Claims 1 - 20 stand rejected by the Examiner.

Claim 19 has been amended, without prejudice, herein.

## **REMARKS**

Reconsideration of the present Application is respectfully requested.

### **Claim Rejections Pursuant to 35 U.S.C. 112, Second Paragraph**

Claim 19 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out an distinctly claim the subject matter which applicant regards as the invention.

35 U.S.C. 112, second paragraph, states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The present office action rejects Claim 19 for depending from a claim which is not recited.

Applicant respectfully submits that Claim 19, as amended, satisfies 35 U.S.C. § 112.

### **35 U.S.C. 102(b) Rejections**

Claims 1, 2, 4-13, 16, 17 and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Marino et al. (U.S. Patent No. 5,605,230). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. 102(b) recites:

A person shall be entitled to a patent unless - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

Consistently, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See, M.P.E.P. §2131 citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).*

Applicant respectfully submits Marino fails to teach each of the limitations of independent Claim 1. Applicant agrees with Examiner that Marino does not disclose a label which is secured about a periphery of a container and a portion of the cap. However, the Examiner further states that the claim "merely states that the label is *suitable* for being secured to a portion of the cap, not that it is actually secured there." (See page 2, paragraph 4 of Official Action.) Applicant respectfully submits the present invention relates to a labeling apparatus, and not to a sealed container and cap with a label secured to it. Therefore, it is irrelevant whether the labeling apparatus is ***actually secured*** to the container and cap. How one ***actually uses*** the present invention does not bear on the patentability of the present invention. The term "suitable" has a common dictionary definition of "adapted to a use or purpose." (Merriam-Webster's Dictionary.) Thus, the present invention is uniquely *adapted* for a use, which is the securing about a periphery of a container and a portion of a

cap. Marino does not teach, nor suggest in any way, a label capable of being secured to a container and a portion of the cap, no less being adapted to such a use. Therefore, Applicant respectfully submits that the 35 U.S.C. 102(b) rejection based upon Marino is improper.

Further, in the rejection of independent Claim 17, the Examiner states that Claim 17 is anticipated by Marino. (See page 2, paragraph 4 of Official Action.) However, the Examiner offers no explanation as to why Marino anticipates Claim 17. For at least the same reasons given above, Applicant respectfully submits Marino does not teach, or even suggest a method of making a labeling apparatus involving a label suitable for being secured about a periphery of said container and to a portion of said cap, as recited in Claim 17.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. 102(b) rejections of Claims 1 and 17, as Marino fails to teach the invention recited in Claims 1 and 17. Further, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. 102(b) rejections of Claims 2-16 and 18-20, as each of these Claims ultimately depend from a patentably distinct independent base claim.

#### **Rejections based on 35 U.S.C. § 103 (a)**

Claim 14 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Marino et al. (U.S. Patent No. 5,605,230) in view of Bernier et al. (U.S. Patent Application Publication No. 2003/0061750). Claims 15, 18 and 19 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Marino et al. (U.S. Patent No. 5,605,230). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. 103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits the cited references, either separately or in combination, fail to either teach or suggest at least each of the limitations of Claims 14, 15, 18 and 19. For at least the reasons set forth hereinabove, Marino fails to teach each of the limitations of independent Claims 1 and 17. Specifically, Marino fails to teach, or even suggest, a label suitable for being secured about a periphery of said container and to a portion of said cap as recited in Claims 1 and 17. Further, Bernier relates to a removable label capable of readhering to another surface. Bernier fails to teach, or even suggest, a label suitable for being secured about a periphery of said container and to a portion of said cap as recited in Claims 1 and 17. In addition to the complete absence of at least this limitation, there is no suggestion or motivation to modify any single reference or to combine these reference teachings. Accordingly, Applicant submits at least Claims 1 and 17 are patentably distinguishable over the prior art of record. Applicant further submits that Claims 14, 15, 18 and 19, and for that matter, all of Claims 2-16 and 18-20 are similarly distinguishable over the prior art

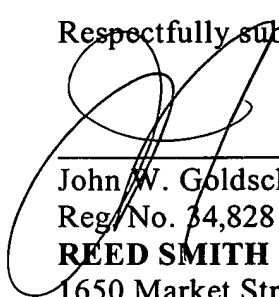
of record, at least by virtue of their ultimate dependency from a patentably distinct base Claim 1 or 17.

### **CONCLUSION**

Wherefore, Applicant believes that all outstanding grounds raised by the Examiner have been addressed and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Date: December 16, 2004

Respectfully submitted,



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